Supreme Court of the United States.

EMILIE SAXLEHNER, Petitioner, vs. EISNER & MENDELSON COMPANY.	October Term, 1900. No. 29.

BRIEF ON BEHALF OF PETITIONER ON MOTION TO MAKE DECREE MORE DEFINITE AND CERTAIN.

This motion is made at the suggestion and in consequence of the action of the Judge of the Circuit Court, to whom a proposed interlocutory decree was presented by the petitioner, complainant, praying for an injunction against the use of her style of bottle, label and capsule, substantially as prayed by her in her bill of complaint. The Judge declined to sign and enter such decree and likewise declined to enter a decree presented by the defendant, which latter was substantially like the decree originally entered by the Circuit Court on April 29, 1898, erasing therefrom such portions as related to the Seal Brand label. The Court, after carefully reading the opinion of this Court, delivered on October 15, 1900, remained in doubt as to whether the concluding clause of that

opinion directed him to enter a decree like that of April 29, 1898, with the Seal Brand label matter eliminated from it, or directed him to enter a decree containing the provisions of the former decree, but providing also for an injunction against the use of the bottle and capsule, to the protection of which the complainant had been found to be entitled and which had been found to be infringed upon by the defendant. Being unable to remove this doubt, the Circuit Court certified it, as shown by the moving papers, and the petitioner respectfully asks that the directions of the decree be made so definite and certain as to enable her to get the decree which she earnestly believes the Supreme Court intended to grant her.

This Court found:

> "2. That in the shape of his bottles, the "design of his capsules and his labels, he "(Saxlehner) was originally entitled to be "protected against a fraudulent imitation,"

and further:

> "We are of opinion, however, that as de- "fendant's bottle and label are a clear in- "fringement upon those of the plaintiff, it "would be destructive to her just rights to "permit the use of such bottles and labels by "the defendant, notwithstanding the affixing "of the Seal Brand, which is a mere private "mark of the importer."

This finding, which was the same in the Circuit Court, would clearly have entitled the complainant to an injunction in accordance with the prayer of her complaint, and, as we respectfully submit, entitles her to ask for such a decree now. The prayer of her complaint was to enjoin the defendant "from "procuring, parting with, selling or attempting to "sell within the said limits, any such water in any "bottle or vessel imitating or resembling in "form, color and general appearance those used "as aforesaid by your orator and her prede-

"cessor in business, OR bearing upon it any "capsule stamped in any manner imitating or "resembling the said capsules of your orator, OR "any label in form, color, design and general ap- "pearance imitating or resembling the said label of "your orator on the said bottles of Hunyadi Janos "water, and also from procuring, parting with or "selling or attempting to sell within said limits any "such water put up or contained in bottles resem- "bling and bearing capsules, marks and labels re- "sembling those of your orator" (Record, p. 6).

The Circuit Court unfortunately came to the opinion that the affixing of the Seal Brand labels sufficiently differentiated defendant's bottles for which reason the complainant could not then successfully insist upon all the relief as to the shape of the bottles and the design of the capsules which she had prayed, and for this reason the decree of April 29, 1898, only gave her an injunction upon her label whether used upon a bottle similar to complainant's or not. That same decree recites that the defendant has wrongfully and fraudulently sold "bitter water in bottles like those used "by complainant for her said Hunyadi Janos bitter "water, the same being of a straight shape with "a short neck and bearing labels," &c. (Record, p. 629), but fails to enjoin the defendant from the use of such bottles or of the capsules. The Circuit Court could not consistently grant to the complainant the injunction prayed by her upon these matters and at the same time hold that the affixing of the Seal Brand label to the same bottles excused the defendant.

The assignment of errors made by the complainant to the Circuit Court of Appeals included every portion of the relief which the complainant had prayed for and which had been withheld from her. It specified the matters on which the Circuit Court had found against the complainant, including specifically the Seal Brand label excuse, but could not specify the shape of the bottle, because on this the

Circuit Court had found in favor of the complainant, who therefore could complain only as to the insufficiency of the relief. This was done by the 11th assignment of errors. But even if insufficiently assigned, or not assigned, this Court undoubtedly had power to notice and correct the error of the Circuit Court in granting to the complainant insufficient relief.

U. S. vs. *Tennessee & C. R. Co.*, 176 *U. S.*, 242, 256.

We submit that under the facts of the case decided by the Circuit Court and approved by this Court, and according to precedent and authority, the complainant was entitled in the Circuit Court to relief by injunction upon each of the matters which had been adopted by her to distinguish her product from that of others, and as to which no defense had been proved, and that the bottle and capsule were as important elements to be protected as the label. The peculiar bottle described in the opinion of this Court adopted by Saxlehner and used by the defendant for the purpose of simulation, is one of the main insignia by which Saxlehner's property is recognized, and to enjoin the label merely, leaving the bottle and capsule in the hands of the defendant, does not give her the relief to which she is entitled.

In the case of *Manufacturing Co.* vs. *Trainer*, 101 U. S., 51, 54, this Court, speaking through Mr. Justice Field, said:

> "*The owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed.*"

In accordance with this principle it has been the uniform practice of the courts, established by many adjudications, of enjoining a party guilty of unfair

competition from using not only the labels under which he sold his imitating wares, but also the bottles or packages by means of which he contrived to pass his goods as those of the complainant.

In the case of *Charles E. Hires Company* vs. *Consumers' Company*, 100 Fed. Rep., 809, the Circuit Court of Appeals for the Seventh Circuit enjoined a manufacturer of root beer from using a new and peculiar form of bottle adopted by the complainant as one of the distinguishing marks of his goods, saying:

> "*It was this distinguishing feature which caught the eye and abided permanently in the memory. Indeed, the Court below declared in its opinion that the changes made by the defendant in its label tended to deceive 'when taken in connection with the shape of the bottle,' thus clearly recognizing the fact that the form of the bottle employed was an effective factor in the deceptive practice. Any restraint, therefore, that did not include the form of bottle would be ineffective to stay the wrong*" (*pp.* 812 *to* 813).

The injunction granted by that Court was substantially that prayed in the bill of complaint herein.

The case of *Moxie Nerve Food Co.* vs. *Baumbach*, 32 Fed. Rep., 205, is another illustration, Judge Sabin, saying:

> "*There is room enough in the world for all, and so there are bottles and styles of packages enough for all; and if a man has an article which, either by accident or design, happens to have the same quality, and be entitled to the same descriptive class of goods, and of the same taste, flavor and color, as another's, and when used, is used in the same way, or is in imitation of another's article, and he finds that his neighbor is making money by vending such article of his own, why then, and in such case, let him use a different kind of bottle or package in placing his own preparation before the public, to the end that he*

may neither derive advantage over his neighbor, nor induce the party to buy one thing when they think that they are buying another" (p. 213).

The same principle has been applied to bottles of peculiar shape, capsules and other marks, in *Cook* vs. *Ross*, 73 Fed. Rep., 203; *Von Mumm* vs. *Frash*, 56 Fed. Rep., pp. 830, 839; *Pillsbury* vs. *Eagle*, 86 Fed. Rep., 608; *Proctor* vs. *Globe Refining Co.*, 92 Fed. Rep., 357; *Dennison Manufacturing Co.* vs. *Thomas Manufacturing Co.*, 94 Fed. Rep., 651; *Sawyer Crystal Blue Co.* vs. *Hubbard*, 32 Fed. Rep., 388, and many others.

It would seem to us to demand an especially strict application in a case where, as in the present case, the defendant is enabled to sell his product under the same trade name which was formerly the complainant's exclusive trade name, to wit, the name "Hunyadi." That being now the case, by the decision of this Court, the principle recently announced by this Court in the case of *Singer Manufacturing Co.* vs. *June Manufacturing Co.*, 163 U. S., p. 169, is directly applicable, namely, that where by public dedication, the right to a former trade name is lost, it is the duty of other parties using the same to so distinguish their goods as to make confusion and deception with the goods of the original manufacturer impossible. This is precisely the situation here, and if the complainant is unable to suppress, as the opinion of this Court says, "*the use of such bottles and labels by the defend-*" *ant*," she will not receive justice at the hands of our Courts. There is no more reason for allowing the defendant the use of that peculiar bottle, without the label, than for allowing the defendant the use of the label without the bottle. Each of them has been found distinctive and adopted by Saxlehner as a peculiar dress for his article and each of them has been found to have been fraudulently imitated and used by the defendant. A complete protection

can be obtained by her only if the defendant is enjoined from the use of every one of the matters imitated by it for deceptive purposes. This, we submit, was the opinion forcibly expressed by this Court in this case, but, in view of the doubt which is entertained by the Court below, we respectfully ask that the directions of the decree be made so certain as to enable the complainant to obtain a decree of injunction upon the style of bottle, label and capsule used by her and every one thereof, in accordance with her prayer of complaint.

Respectfully submitted,

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